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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,172	01/14/2004	Nizar Allibhoy	PU050093	4824

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EXAMINER

ONYEZIA, CHUKS N

ART UNIT	PAPER NUMBER
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3691

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06/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/758,172	Applicant(s) ALLIBHOY ET AL.	
	Examiner CHUKS ONYEZIA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/18/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 July 2007 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/18/2008 has been entered.

Response to Amendment

1. In the amendment filed 05/17/2010, the following has occurred: claims 1, and 16 have been amended, claims 20-28 are canceled. Claims 1-19 are currently presented and have been considered for examination.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must

Art Unit: 3691

(1) be tied to machine (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. . Here the claims fails to meet the above requirements because the steps are neither tied to machine (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. Examiner finds that the recitation of "Database" can reasonably be interpreted as software, merely using paper and pen, or the human mind.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3691

Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. examiner notes that the recitation of "Network operator" as claimed is reasonable interpreted as a limitation that is directed to a human. in the amended preamble of claim 1 applicant attempts to define network operator as a third party separate from user receiver and content provider. for this reason examiner has not given the limitation of network operator patentable weight

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-5, 7-9, and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger, U.S. Patent No. 6,296,185 B1 (PTO-892 Reference A) in view of Payton U.S. Patent No. 5,790,935 (PTO-892 Reference C).

Art Unit: 3691

7. As per claim 1, Dejaeger teaches a method of tracking at least one financial transaction between a user receiver and at least one content provider which transmits on-demand content to the user receiver by a network, wherein the tracking method is performed by a third party separate from the user receiver and separate from the at least one content provider, the method comprising the steps of:

- a. storing preliminary information said at least one financial transactions in a third party controlled data base (see column 34 lines 44-58);
- b. obtaining supplemental information for said at least one financial transactions in said third party controlled data base, wherein said obtaining step is performed by the third party (column 34 lines 44-58);
- c. storing said supplemental information for said at least one financial transactions in said third party controlled data base (column 34 lines 44-58);
- d. displaying summary information for each of the plurality of financial transactions upon receipt of a display request from the user receiver, wherein said summary information is comprised of at least a portion of said stored preliminary information (column 16 lines 48-56)

Art Unit: 3691

examiner interprets the users operation of the checkout system as a request;

e. permitting selection of one or more of the financial transactions from said at least one financial transaction by the user receiver for finalization (column 10 lines 62-67);

f. finalizing said selected one or more financial transactions (column 11 lines 14-25); and

g. providing transaction finalization information to each of the at least one content providers affected by said selected one or more financial transactions wherein content corresponding to each of said selected one or more financial transactions is authorized to be transmitted to said user receiver by said at least content providers affected by said selected one or more financial transactions.(column 27 lines 25-32).

However, Dejaeger does not explicitly disclose the request being for "on-demand content". Payton discloses a system that receives a subscribers request for on-demand content (see Payton Fig 3b). It would have been obvious to combine the teachings of Dejaeger with those of Payton for the purpose of broadening the types of goods and services that are allowed to be purchased.

Art Unit: 3691

8. As per claim 2, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches the step of displaying at least one advertisement simultaneously with said summary information (column 59 lines 47-65).

9. As per claim 3, Dejaeger teaches the above limitations of claim 2. Dejaeger further teaches said at least one advertisement includes linking information to a specific content provider (column 59 lines 47-65).

10. As per claim 4, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches said summary information is comprised of purchase tracking information (column 16 lines 48-56).

11. As per claim 5, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches said summary information is comprised of purchase status information (column 16 lines 48-56).

12. As per claim 7, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches said finalizing step is further comprised of the step of displaying at least one checkout display screen (column 16 lines 48-56).

13. As per claim 8, Dejaeger teaches the above limitations of claim 7. Dejaeger further teaches the step of displaying at

Art Unit: 3691

least one advertisement simultaneously with said at least one checkout display screen (column 59 lines 47-65).

14. As per claim 9, Dejaeger teaches the above limitations of claim 8. Dejaeger further teaches said at least one advertisement includes linking information when selected by a user allows said user to access a specific content provider (column 59 lines 47-65).

15. As per claim 12, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches the steps of: permitting selection of one or more of the financial transactions by the user receiver for additional information inquiry; obtaining said additional information for said selected financial transactions from said third party controlled data base; and displaying said additional information for said selected financial transactions (column 34 lines 44-58).

16. As per claim 13, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches the steps of: permitting selection of one or more of the financial transactions by the user receiver for additional information inquiry; obtaining said additional information for said selected financial transactions from the at least one content provider affected by said selected one or more financial transactions; and displaying said

Art Unit: 3691

additional information for said selected financial transactions (column 34 lines 44-58).

17. As per claim 14, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches the step of finalizing said selected one or more financial transactions is performed by a network operator (column 34 lines 40-54).

18. As per claim 15, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches the step of charging each of the at least one content providers affected by said selected one or more financial transactions (column 26 lines 47-66).

19. As per claim 16, Dejaeger teaches the above limitations of claim 15. Dejaeger further teaches said charging step is performed by said network operator of said network (column 26 lines 47-66).

20. As per claim 17, Dejaeger teaches the above limitations of claim 15. Dejaeger further teaches said fee is based on a total number of finalized financial transactions (column 26 lines 47-66).

21. As per claim 18, Dejaeger teaches the above limitations of claim 15. Dejaeger further teaches said fee to a specific content provider of said at least one content providers is based on a total number of finalized financial transactions occurring

Art Unit: 3691

between said user receiver and said specific content provider (column 26 lines 47-66).

22. As per claim 19, Dejaeger teaches the above limitations of claim 15. Dejaeger further teaches said fee is based on a cost associated with said finalized financial transactions (column 26 lines 47-66).

23. As per claim 6, Dejaeger teaches the above limitations of claim 1. Dejaeger further teaches the steps of: determining display capabilities for the user receiver; and matching a format, from a Plurality of formats, corresponding to said displayed summary information to said determined display capabilities (column 16 lines 48-56; the interactive customer interface terminal includes a display monitor which is provided to display retail information to the customer during operation of the checkout system. For example, transaction information such as item price, item description, total amount of the transaction, instructions, etcetera is displayed to the customer via the display monitor during operation of the checkout system in either its assisted mode of operation or its self-service mode of operation) examiner notes that a determination of display capabilities and matching format compatibilities is necessary in order to display such information.

while Dejaeger does not explicitly disclose the use of a

Art Unit: 3691

Set top box as the user's receiver, Dejaeger discloses the use of a display monitor as the customer interface (column 16 lines 48-56; the interactive customer interface terminal includes a display monitor which is provided to display retail information to the customer during operation of the checkout system). Payton discloses the use of a subscriber's playback device being a television, audio system, or computer (See Payton Col 4 Lns 50-54). It would have been obvious to exchange the checkout terminal of Dejaeger with the at home user POS display of Payton for the purpose of allowing flexibility of purchase locations.

24. As per claim 11, Dejaeger teaches the above limitations of claim 6. Dejaeger further teaches said displayed summary information utilizes only a portion of said determined display capabilities of the user receiver (See Figure 21).

25. Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dejaeger, U.S. Patent No. 6,296,185 B1 (PTO-892 Reference A) in view of Fields, U.S. Patent No. 4,400,724 (PTO-892 Reference B).

26. As per claim 10, Dejaeger teaches the above limitations of claim 1. However Dejaeger does not teach said displayed summary information is displayed as a semi-transparent screen overlay. The Examiner notes, displaying information in this fashion does not modify the operation of Dejaeger's invention. To modify

Dejaeger's display to include a semi-transparent screen overlay would have been obvious to the skilled artisan because the inclusion of such view would have been an obvious matter of design choice in light of the method already disclosed by Dejaeger (see Fields, column 11 lines 2-7). Such a modification would not have otherwise affected Dejaeger and would have merely represented one of numerous views that the skilled artisan would have found obvious for the purposes of displaying multiple messages, already disclosed by Dejaeger. Additionally, applicant has not persuasively demonstrated the criticality of providing this arrangement versus the arrangement disclosed in Dejaeger. See *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Response to Arguments

27. Applicant's arguments filed 01/25/2009 have been considered but are moot in view of the new ground(s) of rejection.

28. Applicant argues that:

Dejaeger does not disclose "Network operator".

Examiner responds that:

Applicant's argument has been considered but examiner notes that the recitation of "Network operator" as claimed is reasonable interpreted as a limitation that is directed to a human. in the

Art Unit: 3691

amended preamble of claim 1 applicant attempts to define network operator as a third party separate from user receiver and content provider. for this reason examiner has not given the limitation of network operator patentable weight

29. Applicant argues that:

Dejaeger does not disclose "the delivery of on-demand programming".

Examiner responds that:

Applicant is correct. Dejaeger directly teaches a method of tracking financial transactions between user and merchant (see Dejaeger Col. 3 Lns. 19-32). Dejaeger does not explicitly disclose the request being for "on-demand content". Payton discloses a system that receives a subscribers request for on-demand content (see Payton Fig 3b). It would have been obvious to combine the teachings of Dejaeger with those of Payton for the purpose of broadening the types of goods and services that are allowed to be purchased. All that is being done is applying the system of Dejaeger, and allowing for the purchase of 'on demand content' to be one of the underlying transactions.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUKS ONYEZIA whose telephone number is (571)270-1372. The examiner can normally be reached on Monday - Thursday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. O./
Examiner, Art Unit 3691

/Alexander Kalinowski/
Supervisory Patent
Examiner, Art Unit 3691
